

26. (Amended) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

a roller adapted to be rotatably mountable adjacent an upper end of the door opening:

B2 a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively:

guide members adapted to be disposed at the lateral sides of the door opening:  
and

laterally inwardly biasing means for maintaining the curtain taut, and for allowing the curtain to yield depth-wise for an applied force, wherein the laterally inwardly biasing means is movable with the curtain between the blocking and unblocking positions.

### REMARKS

The Applicant's representatives have carefully considered the July 11, 2003 official action and again would like to express their appreciation to the Examiner for his review and discussion of the issues at hand. Claims 1-27 are pending and at issue. The patentability of claims 1-19, the claims originally issued, is not at issue. Only claims 20-27 added in the reissue application have been rejected.

Turning to the recapture rejection, the Applicants representatives have carefully considered the Examiner's position and respond, in short, that it appears as though an impasse has been reached, one that should best be resolved on appeal.

The question of recapture is one of surrender. The official action cites *Hester Industries v. Stein*, which provides that "in a proper case, a surrender can occur through arguments alone." A review the prosecution history shows that the applicant's previous reliance on 'diverging' falls far short of the "critical" and "very material" to patentability standard applied by the Court in *Hester*.

The diverging feature discussed in the action was present in the originally filed claims. The Applicants chose to highlight this novel aspect of their claim to distinguish over the prior art. The official action recounts numerous places where this feature was

highlighted. As the office action correctly states these statements are a "clear indication that Applicant fully considered that the 'diverging' feature rendered his claim allowable." This, however, does not mean that the applicant argued that it was a 'critical' feature of patentability, as *Hester* would suggest is required. If this were the case, then broadening reissue would never be appropriate where any feature of a claim was argued as distinguishing over the prior art. In fact, as pointed out in the Statement of Error, the inclusion of the diverging features was tied to unnecessary limitations in the preamble, which were themselves a by-product of an erroneous focus on a specific environment of use, i.e., a door disposed on a vehicle shelter that included a series of arched members that diverged from top to bottom. Merely relying upon this feature as a distinction does not rise to the "deliberate decision to surrender specific subject matter," required. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 996 (Fed. Cir. 1993).

*Hester* acknowledged that for the question of surrender by argument, you must first determine whether there has been surrender, and then determine whether the asserted reissue claims are being argued as distinguishable in a manner contrary to the arguments made in obtaining the originally issued claims. As clearly provided<sup>ABOVE?</sup>(below), this is not the case.

There are three prior art rejections. Claims 20-22 stand rejected as anticipated by the Tufflex Beam disclosure. Claim 20 has been amended to further clarify that claim and recite a discrete member "disposed such that the elastic member can be stretched laterally between the restricted guide engagement members." This feature is not taught by the prior art.

The office action focuses on the fact that the brochure says that the beam is "resilient" to suggest that the beam is stretched. There is nothing in that document suggesting that the beam may be stretched laterally. Indeed, this is not the case in disclosed structure. The resiliency of the Tufflex beam is provided so that it can flex and return for a drive-thru impact on the curtain (i.e. the beam can bow into and out of the plane of the doorway). It cannot, however, "stretch" laterally.

The Tufflex beam forms the basis of the patent to Warner 5,139,074, already of record. As clearly stated in Warner, the beam is made up of tall, thin strips of rubber, sandwiched within tall, thin strips of metal. In this construction, the resiliency of the materials (combined with their being tall and thin) allows them to bow into and out of the

plane of the doorway for impacts. But clearly the metal strips cannot be "stretched" laterally, and certainly cannot be stretched laterally in the way that the discrete elastic member described in the specification can.

For the reasons provided above, the rejection of claim 20, and claims 21 and 22 depending therefrom, is traversed. Additionally, claims 23 and 24, which also depend from claim 20, stand rejected on prior art grounds as obvious. The rejections acknowledge that the Belgian patent and Coenraets do not teach an elastic or resilient member and point to Tufflex for that teaching. Tufflex, as pointed out above, does not teach the elastic member of claim 20, however. These rejections are also traversed. Reconsideration is respectfully requested.

Turning to claim 26, that claim has been amended to clarify that the "laterally-inward biasing means" is "movable with the curtain between the blocking and unblocking positions". The prior art does not teach the claimed subject matter. Coenraets, which served as the previous basis for rejection of claim 26, does disclose a spring 5, however, that spring clearly does not move with the curtain. The rejection of claim 26 is respectfully traversed.

The Applicants respectfully request clarification on the status of claim 27, to which no prior art rejection has been directed. Although the summary sheet indicates that the claim has been rejected, no specific rejection has been made, and without a rejection there is no need for response. Claim 27 is somewhat similar to claim 20, so perhaps this omission was an oversight. Nevertheless, the applicants will await the next action on the merits before addressing this claim, if that is even necessary then.

For the foregoing reasons, claims 20-27 are believed to be in condition for allowance as has already been re-confirmed for claims 1-19. Reconsideration of the rejections is respectfully requested. This preliminary amendment and accompanying remarks are being filed to clarify the issues in this case and better posture the case for appeal, which may be necessary to resolve the question of recapture.

If the examiner would like to discuss this case in detail with the Applicants' representative, please feel free to contact the below-signed individual.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned **"Version with markings to show changes made."**

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Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

20. (Amended) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

a roller adapted to be rotatably mountable adjacent an upper end of the door opening:

a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively:

guide members adapted to be disposed at the lateral sides of the door opening:

guide engagement members couplable to the curtain for movement therewith and engageable with the guide members to restrict their movement toward the curtain center: and

a discrete elastic member coupled to the curtain for movement therewith and extending laterally across the curtain, and disposed such that the elastic member can be stretched laterally between the restricted guide engagement members.

26. (Amended) A roll-up closure device adapted to be disposed adjacent a door opening and movable between blocking and unblocking position relative thereto, and comprising:

a roller adapted to be rotatably mountable adjacent an upper end of the door opening:

a curtain adapted to be secured at a top end thereof to the roller whereby rotation of the roller causes the curtain to wind or unwind from the roller to move between unblocking and blocking positions, respectively:

guide members adapted to be disposed at the lateral sides of the door opening: and

laterally inwardly biasing means for maintaining the curtain taut, and for allowing the curtain to yield depth-wise for an applied force, wherein the laterally inwardly biasing means is movable with the curtain between the blocking and unblocking positions.